

REMARKS

Upon entry of the present amendment claims 1-10, 12-17, and 19-24 are pending in the application. Claims 15-17 and 19-24 have been withdrawn. Claims 1 and 12 have been amended in accordance with the requirements of U.S. patent practice. Claim 2 has been canceled, and claims 25-28 have been added, leaving claims 1-10, 12-14, and 25-28 for consideration upon entry of the present amendment.

Amendments to the claims, as set forth above, are made in order to streamline prosecution in this case by limiting examination and argument to certain claimed embodiments that presently are considered to be of immediate commercial significance. Amendment of the claims is not in any manner intended to, and should not be construed to, waive Applicants' right in the future to seek such unamended subject matter, or similar matter (whether in equivalent, broader, or narrower form) in the present application, and any continuation, divisional, continuation-in-part, RCE, or any other application claiming priority to or through the present application, nor in any manner to indicate an intention, expressed or implied, to surrender any equivalent to the claims as pending after such amendments or cancellations.

1. Claim Amendments

Claim 1 has been amended to recite the limitation of original claim 2, now canceled, that (a1) comprises "at least one isocyanate-reactive group" (a12).

Claim 12 has been amended to recite that the mica pigment is "coated with a metal oxide layer". Support for this amendment can be found at least on p. 30, l. 25 to p. 31, l. 2.

New claims 25-28 have been added to better define the claimed invention.

Support for new claims 25 and 26 can be found at least in original claims 1 and 2, and on p. 41, ll. 6-7, p. 55, l. 20-21, and p. 58, ll. 1-2.

Support for new claim 27 can be found at least in original claims 1 and 2, and on p. 60, ll. 19-25.

Support for new claim 28 can be found at least in original claims 1 and 2, and on p. 60, ll. 9-10.

No new matter has been introduced by these amendments.

2. Rejection of Claim 12 Under 35 U.S.C. § 112, First Paragraph

Claims 12 stands rejected under 35 U.S.C. § 112, first paragraph, as not being enabling for the use of mica as a conductive pigment.

Claim 12 as currently amended recites that the mica pigment is “coated with a metal oxide layer”. It is respectfully submitted that as amended, claim 12 is enabling. The coated mica pigment is electrically conductive by virtue of the metal oxide coating. The first paragraph of Section 112 requires nothing more than objective enablement. *In re Marzocchi* 169 U.S.P.Q. 367 (C.C.P.A. 1971).

Reconsideration and removal of the rejection is respectfully requested.

3. Rejection of Claims 1-6 on the ground of non-statutory double patenting over claims 1, and 4-17 of Bradford et al., U.S. Patent No. 6,835,759, hereafter Bradford.

The Examiner states, “Although the claims conflicting with Bradford et al. are not identical, they are not patentably distinct from each other because they are directed to the same subject matter; and the scope of the current invention is broader than that of the Application [of Bradford].”

A terminal disclosure in reference to Bradford is submitted herewith. Reconsideration and removal of the double patenting rejection is respectfully requested.

4. Rejection of claims 1-10 and 12-14 under 35 U.S.C. §102(b) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as obvious over Palazzotto et al., U.S. Patent No. 4,642,126, hereafter “Palazzotto” and Zador et al., U.S. Patent No. 4,642,126, hereafter Zador, applied as evidence Dunnavant et al., U.S. Patent No. 4,526,219, hereafter Dunnavant, and further in view of Bastian et al., DE Patent Application No. 4,011,867 A1.

Palazzotto generally discloses an actinic radiation curable composition comprising (a) at least one ethylenically unsaturated monomer, (b) a mixture of one or more diisocyanate or polyisocyanate monomers and one or more diol or polyol monomers, or an epoxy monomer, and (c) a curing agent comprising an organometallic compound and an onium salt. (Abstract, col. 3. ll.42-49).

Zador generally discloses a coated abrasive having at least one layer of adhesive comprising an abrasive grain (col. 5, ll. 45-56), diacrylated monomers (col. 3, ll. 44-12), monofunctional monomers (col. 4, ll. 13-29), acrylated polyester urethane oligomers (col. 4, ll. 31-50), and photoinitiators (col. 5, ll. 7-23).

Dunnavant generally discloses a binder for foundry shapes—cores and molds (col. 3, ll. 11-16). The binder system comprises an unsaturated composition (col. 3, ll. 31-40), and a free radical initiator (col. 3, ll. 54-61). The unsaturated composition comprises monomers, polymers, and mixtures (col. 4, ll. 39-60). Useful unsaturated compositions are epoxy acrylate reaction products and polyester/urethane/acrylate reaction products.

Applicants respectfully traverse the anticipation rejection because all of the elements of claim 1 as herein amended are not present in Palazzotta.

Anticipation requires that all of the limitations of the claim be found within a single prior art reference. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). For a rejection under section 102 to be proper, the cited reference must clearly and unequivocally disclose the claimed subject matter without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference. *In re Arkley*, 172 USPQ 524, 526 (C.C.P.A. 1972).

Claim 1 as herein amended incorporates the limitation of original claim 2, that (a1) comprises “at least one isocyanate-reactive group” (a12), an element which is not present in Palazzotta. Therefore Palazzotta does not anticipate herein amended claim 1 of the present Application.

Applicants also respectfully traverse the obviousness rejection because the combined teachings of all of the cited references do not disclose or suggest the limitation of claim 1 as herein amended that (a1) comprises “at least one isocyanate-reactive group” (a12), an element which is not present in Palazzotta.

To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003); *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974).

Regarding the (a12) limitation, the Examiner states,

The constituent (a1) includes acrylated oligomers as described in [Zador, col. 7, ll. 46-47] prepared by reacting linear polyester **polyol** core (claimed isocyanate reactive group (a12)), terminated with toluene diisocyanate, with 2-hydroxyethyl acrylate [Zador, col. 4, ll. 41-44] such as acrylated oligomers commercially available from Thiokol Corp., Trenton, N.J. under the trademarks Uvithane 783 [Zadora, col. 4, ll. 31-50].

Emphasis added by Examiner.

In citing a linear polyester polyol, Zadora is showing how the acrylated oligomer is made. It is made by reacting a linear polyester polyol core with toluene diisocyanate. The linear polyester polyol is a starting material for making the acrylated oligomer – it is not the acrylated oligomer itself. Its free hydroxyl functionality will be eliminated by reaction with the diisocyanate.

Furthermore, Zadora is silent on the hydroxyl number of the acrylated oligomer. The preferred acrylated oligomers of Zadora are Uvithane 782 and Uvithane 783 (col. 4, ll. 48-40). Zadora describes Uvithane 783 as “an acrylated polyester urethane oligomer with an average molecular weight of about 1200” (col. 8, ll. 44-46). Zadora describes Uvithane 782 as “the same general type of oligomer as Uvithane 783 previously described, but the molecular weight of 782 is about 5500” (col. 10, ll. 30-32). There is no teaching or suggestion that these oligomers having isocyanate-reactive, or hydroxyl functionality.

In contrast, the Applicant teaches a hydroxyl number of 76-90 for component (a12) in Examples 1 and 2 (p. 54, ll. 13-17). Examples 3 and 4 use the same acrylated oligomer (p. 57, ll. 7-9).

Since it is not unequivocally demonstrated that element (a12), “at least one isocyanate-reactive group” of herein amended claim 1 is present in either Palazzotta or Zadora, a prima facie case of obviousness has not been made.

Even if the acrylated oligomers of Zadora did have isocyanate-reactive (e.g. hydroxyl) functionality, there is no motivation to combine these oligomers with the composition of Palazzotta. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *DyStar Textilfarben GmbH & Co. Duetschland KG v. C.H. Patrick Co.*, 464 R.3d 1356, 1360, 80, USPQ2nd 1641, 1645 (Fed. Cir. 2006).

As mentioned above, Palazzotta teaches one or more diol or polyol monomers. Since this component of the composition of Palazzotta already has isocyanate-reactive functionality, there is no motivation in either reference to provide the oligomeric component corresponding to (a1) of the present application with additional isocyanate-reactive functionality. Since a motivation to combine the references has not been provided, a prima facie case of obviousness has not been made.

For all of the above reasons, a prima facie case of obviousness has not been made. Therefore, reconsideration and removal of the obviousness rejection of independent claim 1 as herein amended is requested. Since claims 3-10 and 12-14 depend from and further limit claim 1, that these claims are also not obvious. Withdrawal of these rejections is respectfully requested as well.

CONCLUSION

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing amendments and remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

/MaryEGolota/

Mary E. Golota
Registration No. 36,814
Cantor Colburn LLP
(248) 524-2300

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CORRESPONDENCE ADDRESS ONLY

BASF CORPORATION
1609 Biddle Avenue
WYANDOTTE, MI 48192
Customer No. 26922

MEG/DJJ